

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action dated January 26, 2009 (“*Office Action*”). Claims 1-7, 9, 11, and 13-20 are pending in the Application and stand rejected. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

I. Rejections under 35 U.S.C. § 103(a)

The Examiner rejects Claims 1-7, 9, 11, and 13-20 under 35 U.S.C. §103(a) as unpatentable based on a proposed combination of U.S. Patent No. 6,654,564 issued to Colbourne et al. (“*Colbourne*”), U.S. Patent No. 5,608,562 issued to Delavaux et al. (“*Delavaux*”), U.S. Patent No. 6,456,773 issued to Keys (“*Keys*”), and U.S. Patent Application Publication No. 2003/0031433 issued to Feinberg (“*Feinberg*”). Applicant respectfully traverses this rejection and submits that *Colbourne*, *Delavaux*, *Keys*, and *Feinberg*, whether taken alone or in combination, fail to teach or suggest the combination of limitations recited in the claims.

Consider Applicant’s independent Claim 1, which recites:

A dispersion compensation system comprising:

a dispersion compensation module (DCM) operable to receive optical input and provide optical output having a negative dispersion relative to the optical input;

a dispersion enhancement module (DEM) adapted to be optically coupled between the DCM and an optical fiber having a positive dispersion, the DEM operably including a plurality of dispersion enhancement fibers and operable to selectively increase the positive dispersion provided by the optical fiber by a selected one of a plurality of amounts and to provide the optical input to the DCM, the optical input having a positive dispersion substantially equal to the positive dispersion of the optical fiber plus the selected one of the amounts of dispersion in the DEM; and

a controller operable to determine the negative dispersion of the DCM, to determine the positive dispersion of the optical fiber, and to determine the selected one of the amounts of dispersion in the DEM to provide the optical input having a positive dispersion substantially equal to an inverse of the negative dispersion of the DCM, the controller further operable to detect a switch from the optical fiber to a backup optical transport fiber, the backup transport fiber having a third positive

dispersion, and to reconfigure the dispersion enhancement module to provide a fourth positive dispersion, the sum of the third positive dispersion and the fourth positive dispersion substantially equal to the magnitude of the negative dispersion.

Among other aspects, Applicant respectfully submits that *Colbourne*, *Delavaux*, *Keys*, and *Feinberg*, whether taken alone or in combination, fail to teach or suggest “a controller operable . . . to reconfigure the dispersion enhancement module to provide a fourth positive dispersion, the sum of the third positive dispersion and the fourth positive dispersion substantially equal to the magnitude of the negative dispersion,” as Claim 1 recites.

With regard to these aspects, the *Office Action* states that “[t]he combination before Feinberg already has a controller and already detects dispersion values and configures dispersion enhancement, etc.” *Office Action*, p. 16. The *Office Action* thus points to the same combination of cited elements from the references as teaching two different aspects of Applicant’s independent claims, namely, “to configure the optical switches to establish the optical path” and “to reconfigure the optical switches to establish the second optical path,” as recited, for example, in Claim 16. This same combination of cited elements from the references, however, cannot teach both of these claimed aspects because none of the cited elements teach or suggest reconfiguring the dispersion enhancement module in response to detecting a switch from the optical fiber to a backup optical transport fiber. For at least this reason and other reasons discussed below, Applicant maintains that none of the cited portions of the references teach or suggest “a controller operable . . . to reconfigure the dispersion enhancement module to provide a fourth positive dispersion, the sum of the third positive dispersion and the fourth positive dispersion substantially equal to the magnitude of the negative dispersion,” as Claim 1 recites.

The *Office Action* continues, stating that “[t]he role of Feinberg for the combination is based on Feinberg teaching of a protected optical transmission system where different dispersion compensation values are used for each of the received working and protection signals.” *Office Action*, p. 16. In the cited portion, *Feinberg* explains that if, for example, problems occur on fiber 420, then the system 400 can switch over to fiber 425.” ¶ 42. *Feinberg*’s Figure 4 shows dispersion compensation fibers as part of each path. *Feinberg*’s

switching between paths that each provide their own dispersion compensation fibers, however, fails to teach or suggest “reconfigur[ing] the dispersion enhancement module to provide a fourth positive dispersion, the sum of the third positive dispersion and the fourth positive dispersion substantially equal to the magnitude of the negative dispersion,” as Claim 1 recites. In fact, *Feinberg*’s switching between paths that each provide their own dispersion compensation fibers teaches away from reconfiguring the dispersion enhancement module in response to detecting a switch from the optical fiber to a backup optical transport fiber, as Claim 1 recites. *Colbourne*, *Delavaux*, and *Keys* fail to remedy the deficiencies of *Feinberg*, as the Examiner appears to agree. *Office Action*, p. 4. Thus the combination of *Colbourne*, *Delavaux*, *Keys*, and *Feinberg*, as proposed by the *Office Action*, is improper because *Feinberg* teaches away from the proposed combination in contradiction to the rationale relied upon by the Examiner.

The *Office Action*’s combination of *Colbourne*, *Delavaux*, *Keys*, and *Feinberg* is also improper because it is based on impermissible hindsight. The controlling case law, rules, and guidelines repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states that “[t]he tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142.

Accordingly, Applicant respectfully submits that *Colbourne*, *Delavaux*, *Keys*, and *Feinberg*, whether taken alone or in combination, fail to teach or suggest “a controller operable . . . to reconfigure the dispersion enhancement module to provide a fourth positive dispersion, the sum of the third positive dispersion and the fourth positive dispersion substantially equal to the magnitude of the negative dispersion,” as Claim 1 recites. Likewise, independent Claims 9, 13, and 16 include limitations that, for substantially similar reasons, are not taught or suggested by the references. Because *Colbourne*, *Delavaux*, *Keys*, and *Feinberg*, whether taken alone or in combination, fail to teach or suggest all limitations of independent Claims 1, 9, 13, and 16, Applicant respectfully requests reconsideration and allowance of Claims 1, 9, 13, and 16, and their respective dependent claims.

CONCLUSION

Applicant has made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned Attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any extra fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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